

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent Application of)
Karin Axelsson)
Application No. 09/891,380) Confirmation No. 2566
Filed: June 27, 2001) Group Art Unit: 2623
For: Cross-Device Sharing of Reminders) Examiner: Usha Raman
)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Box AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-14501

Sir:

Applicants respectfully request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated in the below remarks. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

Remarks

Having received and reviewed the final Office Action dated June 29, 2006, Applicants respectfully submit that the standing rejection is based on one or more clear errors, and that the appeal process can be avoided through a pre-appeal brief review as set forth in the Official Gazette notice of July 12, 2005.

The specific errors relied upon in this Pre-Appeal Brief Request for Review include the following:

- The pending 35 U.S.C. §103 rejection fails to address several of the claim limitations

A. The Asserted References Do Not Address All Claim Limitations

The pending application is directed towards “an electronic program guide system and a method for notification of programs to a friend or other persons.” (Sub. Spec., Field of the Invention, paragraph 1, lines 2-3). Independent claims 1, 18 and 29 recite systems and methods including the transmission of an alert message for notification of the program selected from the electronic program guide (“EPG”). (see, e.g., claim 18: “transmitting an alert message indicating said notification to an SMS server to be forwarded as an SMS to a mobile handset”; see also independent claims 27 and 28 reciting “obtaining transmission of an alert message.”) Claims 30 and 31 recite the reception or reception means for receiving the notification of the selected program.

The Examiner asserts Alexander discloses an EPG system comprising, *inter alia*, a notification means and a transmission means. (Office Action dated June 29, 2006; pages 3-4). The Examiner, however, concedes that Alexander does not disclose the step of “transmitting a notification of the program selected from the EPG to at least one remote program guide system using the communication network”, but believes this limitation is met by Haken. (*Id.* at 3). The Applicants respectfully disagree that the claim limitations are taught, disclosed, or otherwise suggested by either of the references, either individually or in combination.

1. Haken’s Scheduling of Recordings Does Not Meet the Claim Limitations

Haken discloses the transmission of commands via an Internet connection to remotely control a PTR, however, there is no suggestion or indication of transmitting alert messages as recited in the rejected claims. In the Background Section, Haken suggests the use of remotely programming PTRs through a PDA, etc., where a user can utilize the PDA to schedule a recording on their PTR or another's PTR. Specifically, Haken states that the applications discloses systems and methods “which will permit a PTR to receive changes to a recording schedule transmitted from a remote location” and “which permits the PTR to be programmed [by] any client device.” (Haken, Page 1, Paragraph 8; emphasis added).

In furtherance of paragraph 8, paragraph 33 of Haken further elaborates on the suggested systems and methods in relation to Figure 5A. As explicitly stated, “Fig. 5A is a flowchart illustrating steps employed in authorizing remote scheduling operations.” (Haken, page 3,

paragraph 33). This is distinctly different than “transmitting an alert message indicating said notification” where the notification is of the program **already** selected. Further, while paragraph 39 of Haken mentions a PDA, there is no teaching or suggestion of an alert message as claimed. Nor is there any teaching of utilizing SMS for doing so. Rather the only discussion relates to “enabl[ing] users to program their PTRs”. The remote scheduling of recordings is distinctly different than transmitting alert messages as recited in the independent claims. For at least these reasons, Applicants respectfully request reversal of the rejection.

2. Haken’s “Recommended” Events Do Not Meet the Claim Limitations

The Background section of Haken further proposes systems and methods “which will permit the owner of a first PTR to communicate recommended recording events to other owners of PTRs.” (Haken, Background of the Invention Section, page 1, paragraph 8). Paragraph 38 appears to provide the only discussion of such a feature, where users may send “lists of program titles, times, etc. which the user of PTR 100A thinks that [other PTR users] may like to record or watch.” (Emphasis added). First, this only allows users to send potential program information that other PTR users may like to watch, there is no “transmitting an alert message indicating said notification” of a program selected. Second, the “recommendations” may only be sent to others having a PTR. There is no teaching or suggestion of sending a message to an SMS server to be forwarded as an SMS or otherwise transmitted via SMS as recited in each of the independent claims. Nor can there be a “mobile handset” as recited in claims 1, 18, and 27-29. For at least these reasons, Applicants respectfully request reversal of the rejection.

While Applicants believe the above points represent the clearest errors made by the Office, Applicants reserve the right to appeal on other bases and errors. In addition, Applicants believe the rejections of other claims not identified above are also based on one or more Office errors. Applicants will address such issues on appeal should the appeal of this case proceed after the Office’s consideration of this paper.

CONCLUSION

All issues having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same.

However, if for any reason the review panel believes the application is not in condition for allowance or there are any questions, the review panel is invited to contact the undersigned at (312) 463-5434.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated this 28th day of December, 2006

By: /Shawn P. Gorman/
Shawn P. Gorman
Registration No. 56,197
BANNER & WITCOFF, LTD.
10 S. Wacker Drive
Suite 3000
Chicago, IL 60606-7407
Telephone: 312-463-5000
Facsimile: 312-463-5001

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 006917.00010
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____	Application Number 09/891,380	Filed June 27, 2001
First Named Inventor Karin Axelsson		
Art Unit 2623	Examiner Usha Raman	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>		
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>56,197</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>		
<p style="text-align: right;">_____ /Shawn P. Gorman/ Signature Shawn P. Gorman Typed or printed name 312-463-5000 Telephone number December 28, 2006 Date</p>		
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>		

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. This burden does not include the time for an individual to comment on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.